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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,963	05/22/2001	Masatoshi Takashima	450100-03196	9771
20999 7590 03/23/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER RAMAKRISHNAIAH, MELUR	
			ART UNIT	PAPER NUMBER
			2614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/862,963	Applicant(s) TAKASHIMA ET AL.	
	Examiner Melur Ramakrishnaiah	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-20,25,26,29,30,32-51 and 56-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-20,25,26,29,30,32-51 and 56-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5-28-2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-12, 13-19, 32-43, 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (WO 99/12349, hereinafter Hendricks) in view of Sawyer (US PAT: 6,084,628, filed 12-18-1998).

Regarding claim 1, Hendricks discloses a communication control apparatus for controlling multipoint communications performed using a plurality of communication apparatus connected via, a communication lines, comprising: a control means for controlling communications so as to transmit signals received from the plurality of communication apparatus and a signal for providing a predetermined advertising information to the plurality of communication apparatuses (abstract; pages 6-7; page 14 lines 6-15; page 33; page 36 lines 2-4; figs 1, 10-12, 14, 16, 17).

Regarding claim 13, Hendricks discloses a communication control apparatus for controlling multipoint communications performed using a plurality of communication apparatus connected via, a communication lines, comprising: a control means for controlling communications so as to transmit signals received from the plurality of communication apparatus and a content signal specified by a communication apparatus to the plurality of communication apparatuses (abstract; pages 6-7; page 14 lines 6-15; page 33; page 36 lines 2-4; figs 1, 10-12, 14, 16, 17).

Hendricks differs from claims 1 and 13 in that although he teaches providing advertisements to users, he does not specifically teach: the control means determines the type of advertising information to be provided in accordance with instruction from a communication apparatus and controls communication so as to transmit a signal for providing the determined type of advertising information to the communication apparatus.

However, Sawyer discloses system and method of providing targeted advertising during video telephone calls which teaches the following: the control means in (23, fig. 2) determines the type of advertising information to be provided in accordance with instruction from a communication apparatus (reads on 17/18, fig. 2) and controls communication so as to transmit a signal for providing the determined type of advertising information to the communication apparatus (fig. 2; col. 2 lines 43-17; col. 3 lines 1-51).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Hendricks' system to provide for the following: the control means determines the type of advertising information to be provided in accordance with instruction from a communication apparatus and controls communication so as to transmit a signal for providing the determined type of advertising information to the communication apparatus as this arrangement would facilitate to provide advertisements based on callers preferences so that they will be more effective for users in videoconference call as taught by Sawyer (col. 1 lines 31-37).

Claim 32 is rejected on the same basis as claim 1.

Claim 44 is rejected on the same basis as claim 1.

Regarding claims 2, 4-12, 14-19, 33-43, 45-50, Hendricks further teaches the following: control means controls communications so that the communication apparatus display images in accordance with the signals received from the plurality of communication apparatuses and an image in accordance with the signal for providing the predetermined advertising information on screen as shown in fig. 16, control means assigns predetermined selection right to a communication apparatus and allows the communication apparatus assigned the selection right to give the instruction, control means changes the communication apparatus assigned the selection right in accordance with a request for a communication apparatus, control means transmits a signal for a display for specifying the communication apparatus assigned the selection right to the plurality of communication apparatuses, control means determines whether or not to transmit a signal for providing the advertising information in accordance with an instruction from a communication apparatus, signals are received from the communication apparatuses are signals for displaying faces of users of the communication apparatuses as shown in fig. 16, control means controls communication so that a communication apparatus displays a second image in accordance with the preadvertising information larger compared with first images in accordance with signals from the plurality of communication apparatuses, control means controls communication so that the second image is displayed below the first images in a display of the communication apparatus, charging means for determining fees to be charged to users of the communication apparatus for use of the multipoint communication in accordance

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with provision of advertising information, control means controls communication so as to transmit sound signals received from the plurality of communication apparatuses, when signals are received from the plurality of communication apparatuses are sound signals (abstract; pages 6-7; page 14 lines 6-15; page 33; page 36 lines 2-4; figs 1, 10-12, 14, 16, 17).

3. Claims 25, 26, 29, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (US PAT: 6,600,725 B1, Provisional application No. 60/112,740, filed on Dec. 16, 1998) in view of Sawyer.

Regarding claim 25, Roy discloses a communication apparatus for multipoint communications with plurality of other communication apparatuses via communication lines, comprising: a receiving means in (114, fig. 1) for receiving first signals transmitted by the plurality of communication apparatuses (100, 106, 108, 112, fig. 1, col. 4 lines 1-60) and a second signal indicating predetermined advertising information and a signal processing means for processing for simultaneously displaying images in accordance with the first signals and an image in accordance with a second signal (col. 5, line 66 – col. 6, line 29).

Roy differs from claim 25 in that although he teaches sending advertisements to video conference participants, he does not specifically teach: the receiving means determines the type of advertising information to be provided in accordance with instruction from a communication apparatus and controls communication so as to transmit a signal for providing the determined type of advertising information to the communication apparatus.

However, Sawyer discloses system and method of providing targeted advertising during video telephone calls which teaches the following: the receiving means in (23, fig. 2) determines the type of advertising information to be provided in accordance with instruction from a communication apparatus (reads on 17/18, fig. 2) and controls communication so as to transmit a signal for providing the determined type of advertising information to the communication apparatus (fig. 2; col. 2 lines 43-17; col. 3 lines 1-51).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Roy's system to provide for the following: the receiving means determines the type of advertising information to be provided in accordance with instruction from a communication apparatus and controls communication so as to transmit a signal for providing the determined type of advertising information to the communication apparatus as this arrangement would facilitate to provide advertisements based on callers preferences so that they will be more effective for users in videoconference call as taught by Sawyer (col. 1 lines 31-37).

Claim 26 is rejected on the same basis as claim 25.

Regarding claim 29 and 30, Roy discloses a communication system for multipoint communication using a plurality of communication apparatuses via communication lines under control by a communication control apparatus, wherein: the communication control apparatus (114, fig. 1) comprises control means for controlling communications so as to transmit first signals received from plurality of communication apparatuses (100, 106, 108, 112, fig. 1, col. 4 lines 1-60) and a second signal for providing

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predetermined advertising information to the plurality of communication apparatuses, and the communication apparatus comprises display means (not shown) and a signal processing means (not shown) for processing so as to display images in accordance with the first signals and an image in accordance with the second signal on one display screen means (col. 5, line 66 – col. 6, line 29).

Roy differs from claims 29 and 30 in that he teaches sending advertisements to video conference participants, he does not specifically teach: the control means determines the type of advertising information to be provided in accordance with instruction from a communication apparatus and controls communication so as to transmit a signal for providing the determined type of advertising information to the communication apparatus.

However, Sawyer discloses system and method of providing targeted advertising during video telephone calls which teaches the following: the control means in (23, fig. 2) determines the type of advertising information/content to be provided in accordance with instruction from a communication apparatus (reads on 17/18, fig. 2) and controls communication so as to transmit a signal for providing the determined type of advertising information to the communication apparatus (fig. 2; col. 2 lines 43-17; col. 3 lines 1-51).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Roy's system to provide for the following: the control means determines the type of advertising information to be provided in accordance with instruction from a communication apparatus and controls communication so as to

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transmit a signal for providing the determined type of advertising information to the communication apparatus as this arrangement would facilitate to provide advertisements based on callers preferences so that they will be more effective for users in videoconference call as taught by Sawyer (col. 1 lines 31-37).

4. Claims 20 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Sawyer as applied to claims 13 and 50 above, and further in view of Ito (JP405260193A).

The combination differs from claims 20 and 51 in that he does not specifically teach the following: signals received from the plurality of communication apparatuses are sound signals, the control means recognizes sounds indicated by the sound signals and controls communication so as to transmit signals indicating the recognized sounds by text to the plurality communication apparatuses.

However, Ito discloses video telephone exchange system which teaches the following: signals received from the plurality of communication apparatuses are sound signals, the control means recognizes sounds indicated by the sound signals and controls communication so as to transmit signals indicating the recognized sounds by text to the plurality communication apparatuses (figs. 1-2, abstract; paragraphs: 0004; 0009-0014).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: signals received from the plurality of communication apparatuses are sound signals, the control means recognizes sounds indicated by the sound signals and controls communication

so as to transmit signals indicating the recognized sounds by text to the plurality communication apparatuses as this arrangement would facilitate conferencing among users speaking different languages as taught by Ito.

5. Claims 56-57, 58-60 and 61-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy in view of Bullister (US PAT: 5,886,735).

Regarding claim 56, Roy discloses a communication apparatus for controlling multipoint communication using a plurality of communication apparatus connected via communication line, comprising: a control means for controlling communication so as to permit first signals indicating pick up results of faces of users of the communication apparatuses received from the plurality of communication apparatuses and second signals indicating pickup results to the plurality of communication apparatuses (col. 4 lines 1-60; col. 5, line 66 – col. 6, line 29).

Roy differs from claim 56 in that he does not specifically teach indicating pickup results in the direction of users' perspectives.

However, Bullister discloses video telephone headset, which teaches the following: indicating pickup results in the direction of users' perspectives (abstract; col. 2 lines 20-40; col. 9 lines 36-47; figs. 3, 5A).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Roy's system to provide for the following: indicating pickup results in the direction of users' perspectives as this arrangement would facilitate to obtain line of sight images in a conference system as taught by Bullister (col. 2 lines 35-37), thus making the conference more realistic.

Regarding claim 57, Roy teaches the following: control means in (114, fig. 1) controls communication so that images in accordance with the first signals and second images in accordance with second signals are displayed in correspondence on one screen by the display means of the communication apparatus (col. 5, line 66 – col. 6, line 29).

Regarding claim 58, Roy discloses a communication apparatus for multipoint communication with plurality of other communication apparatus via communication lines, comprising: a receiving means in (114, fig. 1) for receiving signals, a display means (not shown) for displaying in accordance with the received signals, a first image pickup means (not shown) for picking up an image of a face of a user of the communication apparatus, and a transmission means for (120, fig. 1) for transmitting signals indicating the image pickup results of the first image pickup means and second image pickup means (used to provide live information services; col. 5, line 66 – col. 6, line 29).

Roy differs from claims 58-59 in that he does not specifically teach pickup means for picking up the image in the direction of user's perspective and displaying images according to user's perspective

However, Bullister teaches the following: pickup means for picking up the image in the direction of user's perspective and displaying images according to user's perspective (abstract; col. 2 lines 20-40; col. 9 lines 36-47; figs. 3, 5A).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Roy's system to provide for the following: pickup means

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for picking up the image in the direction of user's perspective; displaying images according to user's perspective as this arrangement would facilitate to obtain line of sight images in a conference system as taught by Bullister (col. 2 lines 36-37), thus making the conference more realistic.

Regarding claim 60, Roy teaches the following: display means displays the first images and the second images in correspondence on one screen (col. 5, line 66 – col. 6, line 29).

Claim 61 is rejected on the same basis as claim 56.

Claim 62 is rejected on the same basis as claim 57.

Response to Arguments

6. Applicant's arguments with respect to claims 1-12, 13-19, 25, 26, 29, 30, 32-33, 44-50 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's request to provide translation to JP405260193A, It is provided and will be included in this office action.

Rejection of claims 56-57, 58-60, and 61-62 under 35 U.S.C 103(a) as being obvious over Roy (US PAT: 6,600,756 B1) in view of Bullister (US PAT: 5,886,735): Regarding rejection of claim 56 using the above combination of references, Applicant argues that "Applicant submits that Roy, clearly does not suggest use of second signals indicating pickup results in the direction of users' perspectives to the plurality of communication apparatuses. Therefore, there is no motivation for one skilled in the art to modify Roy's system with video telephone head set of Bullister, when Roy does not teach or suggest indicating pickup results in the direction of user's perspective to the

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plurality of communication apparatuses". Regarding this, rejection of the claim is done under 35 U.S.C 103(a) and office action clearly sets forth reasons for combining references. As stated in the office action: Roy differs from claim 56 in that he does not specifically teach indicating pickup results in the direction of users' perspectives.

However, Bullister discloses video telephone headset, which teaches the following: indicating pickup results in the direction of users' perspectives (abstract; col. 2 lines 20-40; col. 9 lines 36-47; figs. 3, 5A).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Roy's system to provide for the following: indicating pickup results in the direction of users' perspectives as this arrangement would facilitate to obtain line of sight images in a conference system as taught by Bullister (col. 2 lines 36-37), thus making the conference more realistic.

Regarding rejection of claim 56, Applicant further alleges that "Applicants respectfully submit that the Office Action has relied on impermissible hindsight. The motivation or teaching ... Applicant's submit that there is nothing that would motivate a skilled worker in the art to modify Roy in view of Bullister, when Roy lacks very motivation to do so". In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant makes further arguments directed impermissible hindsight reasoning for which examiner responded as set forth above.

Applicant further alleges that "As noted above, the Office Action has merely provided references to teach individual aspects of the claimed invention in total isolation, and has not established a *prima facie* case of obvious. The Office Action has failed to provide an objective reason to combine the disparate and unrelated teaching of the references into the claimed combination". Regarding this, Office Action has not only addressed applicants claim limitation and also provided motivation to combine the references. For example office action clearly states in the rejection of claim 56 the following: As stated in the office action: Roy differs from claim 56 in that he does not specifically teach indicating pickup results in the direction of users' perspectives.

However, Bullister discloses video telephone headset, which teaches the following: indicating pickup results in the direction of users' perspectives (abstract; col. 2 lines 20-40; col. 9 lines 36-47; figs. 3, 5A).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Roy's system to provide for the following: indicating pickup results in the direction of users' perspectives as this arrangement would facilitate to obtain line of sight images in a conference system as taught by Bullister (col. 2 lines 36-37), thus making the conference more realistic.

Thus, Examiner has clearly set forth *prima facie* case of obvious rejection.

Applicants rest of the arguments regarding rejection of claim 56 on page 23 is nothing but reciting the same arguments as motivation to combine the references. As set forth in the office action above, Examiner has clearly provided motivation to combine Roy with Bullister such as to obtain line of sight images in a conference system as taught by Bullister (col. 2 lines 36-37).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614